



PATENT
Customer No. 22,852
Attorney Docket No. 5725.0219-04

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Roland De La METTRIE et al.)	Group Art Unit: 1751
)	
Application No.: 09/904,831)	Examiner: L. Douyon
)	
Filed: July 16, 2001)	
)	
For: OXIDATION DYE COMPOSITION)	
FOR KERATIN FIBERS,)	
COMPRISING NONIONIC)	
AMPHIPHILIC POLYMER)	

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

Pursuant to 37 C.F.R. § 1.193, Appellants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer dated February 4, 2004.

I. Status of the Rejections

In response to the Appeal Brief filed November 4, 2003, claims 30-34 and 37-71 remain rejected under 35 U.S.C. § 103(a) over Dubief et al. (U.S. Patent No. 5,700,456) in view of the International Cosmetic Ingredient Dictionary. The rejection of claim 47 under 35 U.S.C. §112, second paragraph, has been withdrawn in view of the amendment filed concurrently with the Appeal Brief. See Examiner's Answer, page 7.

Also, Appellants note for the record that claim 36 is pending but is not included in this appeal, as the Examiner has indicated it to contain allowable subject matter. This is made clear in the Appeal Brief at page 2, Section III (Status of the Claims) and also at pages 1 and 4. However, Appellants have noticed a typographical error on page 5 of the Appeal Brief, wherein at lines 6 and 9, the recitation of rejected claims mistakenly includes claim 36. The rejected claims, as set forth above, are 30-34 and 37-71.

II. Response to Examiner's Answer

Appellants have considered the Examiner's Answer and, in view of it, have the following remarks.

In the Answer, the Examiner states that the compositions of Dubief "can contain thickening agents like NATROSOL PLUS®...and ...may....contain oxidation dyes," and argues that "a prior art reference is relevant for all that it teaches to those of ordinary skill in the art [and]....for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. Answer, page 7, citing *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) and *Merck & Co. v. Biocraft Labs, Inc.*, 874 F.2d 804 (Fed. Cir.). *cert. denied*, 493 U.S. 975 (1989). See also Answer, page 9. From this, the Examiner concludes, "Hence, Dubief teaches using all the ingredients claimed." Answer, page 8.

Appellants disagree. As an initial matter, the Examiner twice cites *In re Fritch* for the proposition that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art. Answer, page 7 and page 9. Yet, a cursory reading of *Fritch* reveals that, even after considering the cited art "for all that it teaches," the Federal

Circuit found that the art did not provide any incentive for the combination of teachings alleged by the Patent Office to result in Fritch's invention. 972 F.2d at 1266.

Fritch claimed a landscape edging device that was, in its entirety, both flexible and conformable to a ground surface of varying slope. *Id.* at 1262. According to the court, the cited reference, Wilson, showed an edging and watering device flexible in the mower strip portion, but also comprising an anchoring leg for the watering portion which would inhibit flexibility and prohibit conformability to the ground surface for the overall device. *Id.* at 1263. A secondary reference, Hendrix, did not remedy these problems. The court found that Wilson, despite teaching flexibility and conformability in part of its device, provided no teaching suggestion to extend flexibility to its entire device, or to remove the anchoring leg to allow conformability to varying ground surfaces. Citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984), the court held that the mere fact that the prior art could be modified in the manner suggested by the Examiner "does not make the modification obvious unless the prior art suggested the desirability of the modification." 972 F.2d at 1266.

In the present case, Appellants assert that the requirements of the case law, i.e., a reference (1) being "relevant for all that it teaches," (2) being "relied upon for all that it would have reasonably suggested,"¹ and (3) rendering a modification obvious if it "suggests the desirability" thereof, have been misunderstood by the Examiner. The compositions of Dubief may be used for many purposes, including the dyeing of hair, "in which case they contain oxidation dyes and/or direct dyes." Col. 9, lines 19-21. In addition to hair dyeing, Dubief's compositions may be used as treatment compositions

¹ As noted *supra*, the Examiner cites *Merck v. Biocraft* for the proposition that a reference may be relied upon for all that it would have reasonably suggested to one of ordinary skill. Answer, page 7 and page 9.

before or after shampooing; before, during, or after permanent waving; before or after bleaching, straightening, or dyeing hair; and as permanent waving compositions themselves. Col. 9, lines 15-30. These products of Dubief can be in the form of emulsions, dispersions, solutions, fluids, thickened liquids, gels, or creams. Col. 9, lines 32-35.

In a separate part of the disclosure, prior to the discussion in Dubief about forms and uses of his invention, Dubief states that his compositions can contain optional thickening agents and lists examples at col. 8, lines 36-57. No one thickener is associated with any particular type of product, so there is no guidance as to which thickener would work best with, for example, a dyeing composition, or a perming composition, or a pre-treatment composition for straightening hair. In fact, nowhere is it disclosed that a thickener is even necessary or useful for all the different product types encompassed by Dubief. Dubief merely mentions that thickeners can be used, presumably on an as-needed basis. And the thickeners at col. 8, lines 36-57, are not the only means available to “thicken” one of Dubief’s products; he also discloses “viscosity modifiers” in a list of optional additives. See col. 8, line 65.

Thus, Dubief may be relied on “for all that it teaches” and “for all that it would have reasonably suggested,” but the disclosure of both an oxidation dye precursor and a nonionic amphiphilic polymer (NATROSOL PLUS®), in a specification that encompasses many different sorts of cosmetic compositions in various forms and containing various additives, does not add up to a teaching or reasonable suggestion to use these two particular ingredients together. A suggestion to take a certain action, i.e., a suggestion of the “desirability” of taking a certain action, must, in this case, consist of more than the co-existence of two ingredients in a single document. “[I]dentification in

the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000), citing *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). Further, broad conclusory statements about, in this case, the desirability of combining the two separately disclosed ingredients, is not in itself sufficient "evidence." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).² There is simply no specific guidance in Dubief for using any particular thickening agent, out of all of the disclosed thickening agents at col. 8, in an oxidative hair dyeing composition as taught, for example, at col. 9 and in example 6; there is no suggestion that a thickener is even needed, and there is no guidance regarding which thickener to use.

In light of the above, there is insufficient evidence of a suggestion in the cited art to modify Dubief as proposed by the Examiner by adding, as a thickener to its oxidative hair dyeing compositions, cetyl-modified hydroxyethyl cellulose (disclosed by ICID to be NATROSOL PLUS®) to obtain the presently claimed invention. What the Examiner terms "optimization of results" on page 8 of the Answer is really the use of the present invention as a blueprint; in other words, improper hindsight.

The known unpredictability in selecting thickeners for oxidative hair dye compositions, as discussed at length in the Appeal Brief, combined with the lack of motivation to thicken Dubief's oxidative hair dyeing compositions would not engender an expectation of success if one must choose ingredients randomly from within the four corners of Dubief. As a result, the alleged prima facie case of obviousness cannot stand.

² Although *Dembiczak* relates to a rejection using a combination of two references, "the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art." *In re Fritch*, 972 F.2d at 1266.

Accordingly, Appellants maintain their position on all issues covered by the Appeal Brief filed on November 4, 2003, and respectfully assert that a *prima facie* case of obviousness has not been established. Appellants respectfully request reversal of the rejection of claims 30-34 and 37-71 under 35 U.S.C. § 103(a).

III. Conclusion

To the extent any further extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: 
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